REMARKS

Claims 1, 3 – 7, 9 – 11, 33 – 36, 38 – 42, 44 – 47 and 49 – 51 remain in the application. Claims 47 and 49 – 51 have been allowed. Claims 1, 3 – 7, 9 – 11 and 38 – 42 stand finally rejected. Claims 32 – 36 and 43 – 46 are objected to, but are indicated to encompass patentable subject matter. Claims 2, 8, 12 – 31 and 48 are previously canceled (claims 12 – 31 without prejudice as being drawn to a non-elected invention). Claim 37 is canceled herein. Claims 32 and 43 are canceled herein and rewritten as new claims 52 and 53. Claims 1, 33, 38 and 44 are amended herein. No new matter is added.

Claims 32 – 36, and 43 – 46 are objected to for depending from rejected base claims, but are indicated to be allowable, if rewritten in independent form. Responsive thereto, claims 32 and 43 are rewritten in independent form by this proposed amendment as new claims 52 and 53. Therefore, new claims 52 and 53 are allowable. No new matter is added.

Also, claims 33 and 44 are amended to depend from new claims 52 and 53, respectively. Since all claims depending from claims 52 and 53 are allowable, claims 33 – 36 and 44 – 46 also are allowable. Entry of the amendment, reconsideration and withdrawal of the objection to claims 52, 33 – 36, and 53, 4 – 46 and allowance is respectfully requested.

Claims 1 and 3 – 5 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent No. 6,567,763 to Javanifard et al. in view of U.S. patent No. 6,612,738 to Beer et al. Claims 6, 7, 10, 11 and 37 – 42, are finally rejected under 35 U.S.C. §103(a) as being unpatentable over Javanifard et al. and Beer et al. in further view of U.S. patent No. 6,496,056 to Shoji, U.S. patent No. 6,441,679 to Ohshima or published U.S. patent application No. 2003/0025514 to Benes.

In responding to the applicants remarks in the prior Amendment, the final Office action asserts that "any switch, in a broad sense can be considered a shunt because in one position it shorts the circuit and in another position opens the circuit." With regard to the rejection of claim 37, it is that "Benes discloses a device wherein a clamping shunt can be in parallel **or series**." (emphasis added). Other than this general allegation, no specific location is provided for this allegation.

The applicants note that "shunt" is defined as "1a: to turn off to one side : shift <was shunted aside> ... 2: to provide with or divert by means of an electrical shunt" (www.merriam.com). It is well known in the art, that an electrical shunt is in parallel with whatever it is shunting. So, a switch in parallel with a current source can shunt current ("turn off to one side"), a series connected switch cannot. Therefore, while switches may be used as shunts, not every switch is a shunt. Certainly not the switches in the circuits taught by Javanifard et al., Beer et al. or Benes. While Benes may be understood to show input bias resistors (R_L and R_H) in series with switches (S_L and S_H), Benes does not teach a clamping shunt, much less that in spite f the common meaning of "shunt" that "a clamping shunt can be in parallel or series."

Accordingly, claims 1 and 38 are amended by this proposed amendment to recite that the clamping shunt is in parallel with the current source and, therefore, diverts the current to one side, in parallel. Specifically claim 1 is amended to recite that the "clamping device <u>in parallel with said constant current source and</u> selectively shunting current from said constant current source <u>through said clamping device</u>;" at lines 7 – 9. This is supported in the specification by Figures 1 and 3, the written description in general, by canceled claim 37 and objected to claim 46, and the plain meaning of "shunt." No new matter is added. Entry of the amendment, reconsideration and withdrawal of the final rejection under 35 U.S.C. §103(a) of claims 1 and 38 as amended, is respectfully requested.

Furthermore, since dependent claims include all of the differences with the references as the claims from which they depend, the present invention as recited in claims 3 – 5, which depend from proposed amended claim 1, are patentable over Javanifard et al. and Beer et al., alone, or further in combination with any other reference of record. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 3 – 5 under 35 U.S.C. §103(a) is respectfully requested.

> The final Office action further responds to the applicants remarks asserting that with respect to the 'integrated circuit': the preamble of the claims does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and a portion of the claim following the preamble is a self-contained description of the structure not-depending for completeness upon the introductory clause. Kropa v. Robie 88 USPO 478 (CCPA 19511"

Well, what about claims 7 and 42, for example? Claim 7 recites "wherein said IC is on a silicon on insulator chip" and claim 42 recites, "wherein said CMOS IC is on a silicon on insulator (SOI) IC chip." "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP §2141.02(I), (citations omitted, emphasis original). Even a rejection of dependent claims (7 and 42) under 35 U.S.C. §103(a) requires consideration as a whole. Thus,very clearly, the recitations of these two claims cannot be ignored.

So, at least with respect to claims 7 and 42, whether as finally rejected or as amended, the references must show or, at least provide a reasonable expectation of success that the combination of Javanifard et al. with Beer et al. would continue to function in an SOI IC. No such showing has been made. Therefore, the combination of Javanifard et al. with Beer et al. is not suggested by any reference of record and does not result in the present invention as recited in claims 7 or 42, as finally rejected or as

amended. Reconsideration and withdrawal of the rejection of claims 7 and 42 under 35 U.S.C. §103(a) is respectfully requested.

Neither do any of Shoji or Ohshima add anything that is missing from either of Javanifard et al., Beer et al., or Benes to result in the present invention as recited in claims 1 or 38. Therefore, since dependent claims include all of the differences with the references as the claims from which they depend, the present invention as recited in claims 6, 7, 9 – 11, 37 and 39 – 42, which depend from amended claims 1 and 38, are patentable over Javanifard et al. and Beer et al., alone, or further in combination with Benes, Shoji and/or Ohshima. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 6, 7, 9 – 11, 37 and 39 – 42 under 35 U.S.C. §103(a) is respectfully requested.

The applicants have reviewed the reference cited, but not relied upon in the rejection and find them to be no more relevant than the reference upon which the rejection is based.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request that the Examiner enter the amendment, reconsider and withdraw the objection to claims 52, 33 – 36, and 53, 44 – 46, and the rejection of claims 1, 3 – 7, 9 – 11, and 37 – under 35 U.S.C. §103(a), and allow the application to issue.

Should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 50-0510 and advise us accordingly.

Respectfully Submitted,

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(Date)

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